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10/713,180	11/13/2003	Hidetada Nago	1232-5208	9816

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3 WORLD FINANCIAL CENTER  
NEW YORK, NY 10281-2101

EXAMINER
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HOLLIDAY, JAIME MICHELE

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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06/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/713,180	NAGO, HIDETADA
	Examiner Jaime M. Holliday	Art Unit 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 April 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6-12,15 and 16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4,5,13,14 and 17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on January 31, 2007, April 3, 2007 and April 18, 2007, have been considered by the Examiner and made of record in the application file.

***Response to Amendment***

***Response to Arguments***

2. Applicant's arguments filed April 3, 2007 have been fully considered but they are not persuasive.

Applicant basically argues that none of the cited references disclose, teach or suggest "a wireless LAN adapter having a wireless communication unit and a memory." Examiner respectfully disagrees, because as cited in the Noda reference, the IC card (LAN adapter) communicates wirelessly with the IC card contactless communication unit (wireless communication unit) and information is recorded on the IC card (memory) (paragraphs 78-82).

Applicant further argues that none of the cited references disclose, teach or suggest a reading step of "causing the printing apparatus to read Service Set ID from the memory, in a case that the wireless LAN adapter in which the Service Set ID has been registered in said registration step is connected to the printing apparatus." Examiner respectfully disagrees, because as cited the Beach reference, a peripheral device wirelessly communicates with a mobile unit, wherein the peripheral device may

be a printer (printing apparatus) (paragraph 25). Also, Noda discloses that the IC-card contactless communication unit of the access point or personal computer, etc. reads the local-network information recorded in the IC card (reading step). Noda further discloses that the information recorded on the IC card includes SSID information (Service Set ID) (paragraphs 78-85).

Applicant further argues that none of the cited references disclose, teach, or suggest a "setting step of causing the printing apparatus to set the Service Set ID read in said reading step in the wireless communication unit of the wireless LAN adapter connected to the printing apparatus." Examiner respectfully disagrees, because as cited in the Noda reference, the second PC sets (setting step) the network configuration of the wireless communication unit according to the network information read by the IC-card contactless communication unit.

Therefore, in view of the above arguments, Examiner maintains previous rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1, 4, 13 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Noda (U.S. 2005/0015467 A1)** in view of **Bartolome et al. (U.S. 7,149,805 B2)**.

Consider **claims 1 and 7**, Noda clearly shows and discloses communication apparatus and method that allow setting for forming a wireless link. A personal computer **1**, reading on the claimed “external computer,” includes a CPU (central processing unit) **11**, which is connected to an input/output interface **15** via a bus **14**, and furthermore, a ROM (read only memory) **12** and a RAM (random access memory) **13** are connected to the bus. An IC-card contactless communication unit **19** for detecting an IC card **2**, reading on the claimed “wireless LAN adapter having a wireless communication unit and a memory,” when it is placed in close proximity thereto and reading data from and writing data to the IC card, a wireless communication unit **20** for forming a wireless link and exchanging data with, for example, the access-point device **3**, by a wireless communication function conforming to IEEE 802.11b, according to access-point information, local-network information, or the like that is set by the

CPU, (abstract, paragraphs 52-53). The personal computer **1-1**, reading on the claimed "external computer," starts processing when a user performs an operation for requesting that local-network information required for the personal computer **1-2**, reading on the claimed "first apparatus," to form a wireless link with the personal computer be recorded in the IC card. When the user places the IC card in proximity to the IC-card contactless communication unit **19-1** of the personal computer, the IC-card contactless communication unit detects the IC card, and the IC-card contactless communication unit records the local-network information required for the personal computer **1-2** to form a wireless link with the personal computer **1-1** in the IC card, reading on the claimed "registration step," (paragraphs 78 and 80). The personal computer requires an SSID and a WEP KEY defined in IEEE 802.11b to be set before forming a wireless link with the access-point device, reading on the claimed "causing an external computer apparatus to register Service Set ID into the memory, in a case that the external computer apparatus is connected to the wireless LAN adapter, wherein the Service Set ID defines wireless LAN communication of the [printing] apparatus," (abstract, paragraph 50). When the user places the IC card in proximity to the IC-card contactless communication unit **19-2** of the personal computer **1-2**, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit reads the local-network information recorded in the IC card,

reading on the claimed "reading step of causing the [printing] apparatus to read the Service Set ID from the memory, in a case that the wireless LAN adapter in which the Service Set ID has been registered in said registration step is connected to the [printing] apparatus." The CPU **11-2** sets network configuration of the wireless communication unit **20-2** according to the local-network information read by the IC-card contactless communication unit, reading on the claimed "setting step causing the [printing] apparatus to set the Service Set ID read in said reading step in the wireless communication unit of the wireless LAN adapter connected to the [printing] apparatus." Thus, a wireless LAN is formed between the personal computer **1-1** and the personal computer **1-2** in ad-hoc mode, reading on the claimed "communication method for allowing a [printing] apparatus connected to a wireless LAN adapter having a wireless communication unit and a memory, to perform wireless LAN communication, said communication method comprising a communication step of performing wireless LAN communication using the Service Set ID set," (paragraphs 84 and 85).

However, Noda fails to specifically disclose the PC's communicating via the IC-card contactless communication unit.

In the same field of endeavor, Bartolome et al. clearly show and disclose a communication system that may include one or more wireless devices **304**, a network member fixed computer device **311**, and a computer network **318**. The wireless device may be any type of mobile wireless device capable of communicating in a wireless manner with other wireless devices. This may

include radio frequency communication and may additionally include infrared communication. The wireless device may be, for example, a cellular telephone, a pager, a laptop or notebook computer, a pager, a personal digital assistant (PDA), etc. The network member device is not itself a wireless infrastructure device. For example, the network member device 311 may be a personal computer, a network workstation, a dumb terminal, a printer, a copier, a scanner, a facsimile, a disk or tape drive, a disk drive server, etc., reading on the claimed "printing apparatus." The computer network may be a local area network (LAN), a wide area network (WAN), a virtual private network (VPN), etc., reading on the claimed wireless LAN communication," (col. 3 lines 10-50). The network member device may include a wireless communication card **417** that further includes a modem card **424** and an associated antenna **403** and a bridge **429**. The modem card may be any type of standard modem card capable of communicating with a wireless device. The modem card performs data conversion and performs wireless transmission and reception of data, such as through radio frequency (RF) communications. The modem card may operate according to any known wireless protocol, such as cellular formats, BLUETOOTH, etc., reading on the claimed "wireless LAN adapter." In operation, the modem card conducts wireless communications with one or more wireless devices, reading on the claimed "communication step of causing the wireless communication unit of the wireless LAN adapter connected to the printing

apparatus to perform the wireless LAN communication," (col. 5 lines 25-55, col. 6 lines 21-23).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a modem card in a fixed apparatus that can communicate wirelessly with a mobile device as taught by Beach, in the system of Noda, in order to form a wireless link between two apparatuses in a wireless system.

Consider **claim 4**, Noda, as modified by Bartolome et al., clearly show and disclose the claimed invention **as applied to claim 1 above**, and in addition, Noda further discloses that the setting information may include at least one of ID information, a password associated with the ID information, a user name, and a password associated with the user name, reading on the claimed "external computer apparatus further registers identification information of the [printing] apparatus in the memory of the wireless LAN adapter," (paragraph 15).

However, Noda fails to explicitly disclose that either apparatus may be a printer.

In the same field of endeavor, Bartolome et al. further disclose that a fixed network member device that communicates with a wireless device may be a printer, reading on the claimed "printing apparatus," (col. 3 lines 30-35, 58-60).

Consider **claims 13 and 17**, Noda clearly shows and discloses communication apparatus and method that allow setting for forming a wireless link. A personal computer, reading on the claimed "external computer

apparatus," includes a CPU (central processing unit), which is connected to an input/output interface via a bus, and furthermore, a ROM (read only memory) and a RAM (random access memory) are connected to the bus. An IC-card contactless communication unit for detecting an IC card, reading on the claimed "wireless LAN adapter," when it is placed in close proximity thereto and reading data from and writing data to the IC card, a wireless communication unit for forming a wireless link and exchanging data with, for example, the access-point device, by a wireless communication function conforming to IEEE 802.11b, according to access-point information, local-network information, or the like that is set by the CPU, (abstract, paragraphs 52-53). A first communication apparatus that includes wireless communication means for carrying out wireless communication with another electronic apparatus based on a predetermined wireless communication standard and reading means for reading the setting information, by contactless communication, from an information recording medium detected by a detection means. Since the access-point device is capable of writing data to the IC card, it is possible to additionally record user information for forming a link with a wireless LAN that is formed via the access-point device, (fig. 1, paragraphs 10 and 69). When the user places the IC card in proximity to the IC-card contactless communication unit **19-2** of the personal computer **1-2**, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. The personal computer requires an SSID and a WEP KEY defined in IEEE 802.11b to

be set before forming a wireless link with the access-point device, reading on the claimed "register Service Set ID," (abstract, paragraph 50). If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit reads the local-network information recorded in the IC card. The CPU **11-2** sets network configuration of the wireless communication unit **20-2** according to the local-network information read by the IC-card contactless communication unit. Thus, a wireless LAN is formed between the personal computer **1-1** and the personal computer **1-2** in ad-hoc mode, reading on the claimed "[printing] apparatus which is capable of performing wireless LAN communication by being connected with a wireless LAN adapter, comprising detection means for detecting a connection with the wireless LAN adapter; reading means for reading Service Set ID, for which said [printing] apparatus connected to the wireless LAN adapter performs wireless LAN communication, registered in a memory of the wireless LAN adapter by an external computer apparatus in a case that said detection means detects that the wireless LAN adapter is connected to the [printing] apparatus; setting means for setting Service Set ID read by said reading means in the wireless communication unit of the wireless LAN adapter connected to the [printing] apparatus as wireless communication parameters for which the wireless communication unit performs the wireless LAN communication, and wireless communication means for performing the wireless LAN communication using the Service Set ID set in the wireless communication unit," (paragraphs 84 and 85).

However, Noda fails to specifically disclose the PC's communicating via the IC-card contactless communication unit.

In the same field of endeavor, Bartolome et al. clearly show and disclose a communication system that may include one or more wireless devices **304**, a network member fixed computer device **311**, and a computer network **318**. The wireless device may be any type of mobile wireless device capable of communicating in a wireless manner with other wireless devices. This may include radio frequency communication and may additionally include infrared communication. The wireless device may be, for example, a cellular telephone, a pager, a laptop or notebook computer, a pager, a personal digital assistant (PDA), etc. The network member device is not itself a wireless infrastructure device. For example, the network member device **311** may be a personal computer, a network workstation, a dumb terminal, a printer, a copier, a scanner, a facsimile, a disk or tape drive, a disk drive server, etc., reading on the claimed "printing apparatus." The computer network may be a local area network (LAN), a wide area network (WAN), a virtual private network (VPN), etc., reading on the claimed wireless LAN communication," (col. 3 lines 10-50). The network member device may include a wireless communication card **417** that further includes a modem card **424** and an associated antenna **403** and a bridge **429**. The modem card may be any type of standard modem card capable of communicating with a wireless device. The modem card performs data conversion and performs wireless transmission and reception of data, such as

through radio frequency (RF) communications. The modem card may operate according to any known wireless protocol, such as cellular formats, BLUETOOTH, etc., reading on the claimed "wireless LAN adapter." In operation, the modem card conducts wireless communications with one or more wireless devices, reading on the claimed "printing apparatus connected to the wireless LAN adapter performs wireless LAN communication via a wireless communication unit of the wireless LAN adapter," (col. 5 lines 25-55, col. 6 lines 21-23).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a modem card in a fixed apparatus that can communicate wirelessly with a mobile device as taught by Beach, in the system of Noda, in order to form a wireless link between two apparatuses in a wireless system.

6. **Claims 5 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Noda (U.S. 2005/0015467 A1)** in view of **Bartolome et al. (U.S. 7,149,805 B2)**, and in further view of **Sato (U.S. 2003/0009541 A1)**.

Consider **claim 5**, and as applied to **claim 1 above**, Noda, as modified by Bartolome et al., clearly shows and discloses the claimed invention except that the setting information on the IC card is compared to information already stored on the printer.

In the same field of endeavor, Sato clearly shows and discloses a network system that comprises a target device to be managed that is connected to a network, and a management device that manages the target device, reading on the claimed "printing apparatus," wherein the management device enables the target device to establish communications over the network and includes a first integrated circuit (IC) card drive in which an IC card stores communication parameters for enabling the management device to manage the target device, and wherein the target device includes a second IC card drive for reading the communication parameters stored in the IC card to set the communication parameters that have been read. The network system uses the IC card as a relay to perform an initial setting of the communication parameters on the target device. This enables the communication parameters to be set only by insertion of the IC card into the target device, achieving a relatively easy setting operation, (paragraph 10). When a user of the management device 10 withdraws an IC card 50 from the IC card driver 20 of the management device, and carries and inserts the IC card into the IC card driver 70 of the network apparatus 60, the controller 61 reads and sets some of the communication parameters stored in the IC card corresponding to the pertinent network apparatus. More specifically, the controller sets the communication parameters obtained through the IC card drive and the interface 66 on the storage part 65. The controller is required to identify the communication parameters on the pertinent network apparatus among those stored in the IC card. For example, if user ID and password pairs are stored in

the IC card, the controller may invite a user of the network apparatus to enter his/her user ID/password pair, and set the identified communication parameters, reading on the claimed "comparison step of comparing the identification information registered in said registration step with identification information of the printing apparatus previously set in the printing apparatus, wherein the printing apparatus controls performing the wireless LAN communication in said communication step in accordance with the result of comparison in said comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a step of verifying user ID and password as taught by Sato, in the system of Noda, as modified by Bartolome et al., in order to form a wireless link between two apparatuses in a wireless system.

Consider **claim 14**, Noda, as modified by Bartolome et al., clearly show and disclose the claimed invention **as applied to claim 13 above**, and in addition, Noda further discloses a first communication apparatus that includes wireless communication means for carrying out wireless communication with another electronic apparatus based on a predetermined wireless communication standard, reading means for reading the setting information, by contactless communication, from an information recording medium detected by a detection means, and setting means for adjusting setting of the wireless communication means according to the setting information read by the reading means, reading

on the claimed "reading means for reading the identification information from the wireless LAN adapter, wherein the reading means reads the Service Set ID," (fig. 1, paragraphs 10 and 69). The setting information may include at least one of ID information, a password associated with the ID information, a user name, and a password associated with the user name and ID information SSID, reading on the claimed "both the identification information of said printing apparatus as well as the Service Set ID are set in the wireless LAN adapter by the external computer apparatus," (paragraphs 15, 81).

However, Noda, as modified by Bartolome et al., fails to disclose that the setting information on the IC card is compared to information already stored on the second personal computer or access point.

In the same field of endeavor, Sato clearly shows and discloses a network system that comprises a target device to be managed that is connected to a network, and a management device that manages the target device, wherein the management device enables the target device to establish communications over the network and includes a first integrated circuit (IC) card drive in which an IC card stores communication parameters for enabling the management device to manage the target device, and wherein the target device includes a second IC card drive for reading the communication parameters stored in the IC card to set the communication parameters that have been read. The network system uses the IC card as a relay to perform an initial setting of the communication parameters on the target device. This enables the communication parameters to

be set only by insertion of the IC card into the target device, achieving a relatively easy setting operation, (paragraph 10). When a user of the management device withdraws an IC card from the IC card driver of the management device, and carries and inserts the IC card into the IC card driver of the network apparatus, the controller reads and sets some of the communication parameters stored in the IC card corresponding to the pertinent network apparatus. More specifically, the controller sets the communication parameters obtained through the IC card drive and the interface on the storage part. The controller is required to identify the communication parameters on the pertinent network apparatus among those stored in the IC card. For example, if user ID and password pairs are stored in the IC card, the controller may invite a user of the network apparatus to enter his/her user ID/password pair, and set the identified communication parameters, reading on the claimed "second reading means for reading the identification information from the wireless LAN adapter; and comparison step of comparing the identification information read by the second reading means with identification information previously set in said printing apparatus," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a step of verifying user ID and password as taught by Sato, in the system of Noda, as modified by Bartolome et al., in order to form a wireless link between two apparatuses in a wireless system.

***Conclusion***

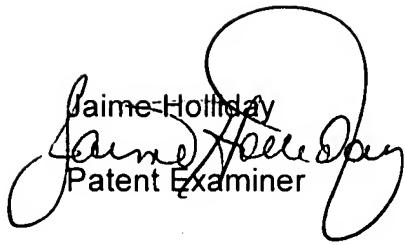
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jaime Holliday  
Patent Examiner

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER